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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/724,676	11/28/2000	Zurit Levine	2786-0238P	9311
2292	7590	12/16/2003	EXAMINER	
BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			MARSCHEL, ARDIN H	
			ART UNIT	PAPER NUMBER
			1631	

DATE MAILED: 12/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/724,676	<b>Applicant(s)</b> LEVINE ET AL.	
	<b>Examiner</b> Ardin Marschel	<b>Art Unit</b> 1631	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 August 2003.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-85 is/are pending in the application.
- 4a) Of the above claim(s) 1, 2, and 4-85 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 3 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-85 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \*    c) ☐ None of:  
         1. ☐ Certified copies of the priority documents have been received.  
         2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
         3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
     \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
     a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) 3 copies (1 sheet)
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

Applicants' arguments, filed 8/28/03, have been fully considered but they are not deemed to be persuasive. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.

### **LACK OF UTILITY REJECTION**

Claim 3 is rejected under 35 U.S.C. 101 because the claimed invention lacks patentable utility due to its not being supported by either specific and/or substantial utility or a well established utility.

This rejection is reiterated and maintained as set forth at length in the previous office action, mailed 2/28/03. Applicants argue that the elected sequences are related to kinases which have a well established utility. In response, the previous office action summarized the speculative and insufficient support for a utility based on sequence similarity. No other support for kinase character or even relatedness has been set forth either as filed or in arguments, filed 8/28/03. Thus, the well established utility of kinases does not support such a utility for the subject matter of instant claim 3. It is noted that applicants have not argued this basis for this lack of utility rejection which was set forth in the previous office action, mailed 2/28/03, inclusive of a series of publications to support the determination that sequence similarity is insufficient to determine the activity of a biomolecule such as a polypeptide. Thus, applicants have not argued the basis for this rejection and is therefore also non-persuasive.

### **LACK OF ENABLEMENT**

Claim 3 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. Due to a lack of either an art recognized or alleged well established utility, the instant invention has been rejected due to also lacking the required combination of a specific, substantial, and credible utility.

This rejection is reiterated and maintained as set forth at length in the previous office action, mailed 2/28/03. Applicants have not argued this rejection beyond the above arguments regarding lack of utility which are equally non-persuasive here.

### **SCOPE OF ENABLEMENT**

Claim 3 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling (subject to the above noted lack of enablement) for SEQ ID NO: 70,493, does not reasonably provide enablement for homologues defined as having sequence additions, deletions, or replaced or chemically modified amino acids in the region that differs from the "original amino acid sequence". The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make/use the invention commensurate in scope with these claims.

Factors to be considered in determining whether a disclosure would require undue experimentation have been summarized in Ex parte Forman, 230 USPQ 546 (BPAI 1986) and reiterated by the Court of Appeals in In re Wands, 8 USPQ2d 1400 at 1404 (CAFC 1988). The factors to be considered in determining whether undue experimentation is required include: (1) the quantity of experimentation necessary, (2)

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the amount or direction presented, (3) the presence or absence of working examples, (4) the nature of the invention, (5) the state of the prior art, (6) the relative skill of those in the art, (7) the predictability or unpredictability of the art, and (8) the breadth of the claims. The Board also stated that although the level of skill in molecular biology is high, the results of experiments in genetic engineering are unpredictable. While all of these factors are considered, a sufficient amount for a prima facie case are discussed below.

This rejection is reiterated and maintained as set forth at length in the previous office action, mailed 2/28/03, and as necessitated by amendment regarding the amended percent homologies. Applicants argue that pages 33-36 of the specification disclose the preparation of nucleic acids including those of the elected species (Refer to example II A). It is acknowledged that homologues may be prepared with a defined sequence identity such as 90% etc. compared to a reference sequence, but that this does not supply splice variant sequence(s) as these will have particular sequences that a generic description does not produce without undue experimentation due to the lack of guidance as to which sequences are specifically splice variants rather than merely variants in sequence. Since these splice variants are not enabled the uses pointed to on pages 37-44 in example II B, example III and pages 51-54 are moot regarding sequence variants which have not been determined to be splice variants per se.

#### **LACK OF WRITTEN DESCRIPTION**

Claim 3 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not

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described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

This rejection is reiterated and maintained as set forth at length in the previous office action, mailed 2/28/03, and as necessitated by amendment regarding the newly added homology percentages. Applicants argue that the 90% identity, but less than 100% identity limitations in claim 3 would result in understanding what sequences are claimed as splice variants. In response, these percentages are acknowledged to define sequence variants, but that the claimed subject matter is not directed to merely sequence variants, but rather splice variants per se. See claim 3, line 4, which directs the claimed subject matter to "splice variants" and not simply sequence variants.

No claim is allowed.

Applicants' amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicants are reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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This application contains claims 1, 2, and 4-85, drawn to an invention nonelected with traverse in Paper No. 9, filed 10/28/02. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

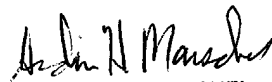
Papers related to this application may be submitted to Technical Center 1600 by facsimile transmission. Papers should be faxed to Technical Center 1600 via the Central PTO Fax Center. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993)(See 37 CFR § 1.6(d)). The Central PTO Fax Center number is (703) 872-9306.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ardin Marschel, Ph.D., whose telephone number is (703)308-3894. The examiner can normally be reached on Monday-Friday from 8 A.M. to 4 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward, Ph.D., can be reached on (703)308-4028.

Any inquiry of a general nature or relating to the status of this application should be directed to Legal Instrument Examiner, Tina Plunkett, whose telephone number is (703)305-3524 or to the Technical Center receptionist whose telephone number is (703) 308-0196.

December 12, 2003

  
ARDIN H. MARSCHEL  
PRIMARY EXAMINER